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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,525	10/11/2005	Katsu Kondo	KPO-SUN-P4/SN-89/US	4420
44702 . 7590 10/04/2010 OSTRAGER CHONG FLAHERTY & BROITMAN PC 570 LEXINGTON AVENUE FLOOR 17 NEW YORK, NY 10022-6894			EXAMINER STULII, VERA	
			ART UNIT 1781	PAPER NUMBER
			NOTIFICATION DATE 10/04/2010	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Mailed:

OCT 04 2010

In re application of
Kondo

Serial No. 10/552,525

Filed: October 11, 2005

For: PROCESS FOR PRODUCING FOOD OR DRINK
FROM MALT ROOT

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:
: DECISION ON
: PETITION

This is a decision on the PETITION FILED UNDER 37 CFR 1.181 on August 16, 2010 to withdraw the final status of the Office Action dated February 22, 2010. The Examiner issued an Advisory on August 8, 2010.

In response to the Final Office Action filed July 21, 2010, Applicants presented arguments that were directed to the English language abstract of the Todorova et al. reference, since only a translation of the abstract was provided to Applicants. The Examiner issued an Advisory Action mailed August 10, 2010 that made it clear the Examiner relied on the entire Todorova et al. reference, written in Bulgarian and not just the English language Abstract.

The Examiner indicated to Applicants that a full translation would be requested and that the final rejection would be withdrawn once the translation was received. Applicant was advised by the Examiner to file a Notice of Appeal or Request for Continued Examination (RCE) in order to keep the case pending.

When an abstract is used to support a rejection, the evidence relied upon is the facts contained in the abstract, not additional facts that may be contained in the underlying full text document. Citation of and reliance upon an abstract without citation of and reliance upon the underlying document is generally inappropriate where both the abstract and the underlying document are prior art. See *Ex parte Jones*, 62 USPQ2d 1206, 1208 (Bd. Pat. App. & Inter. 2001) (unpublished).

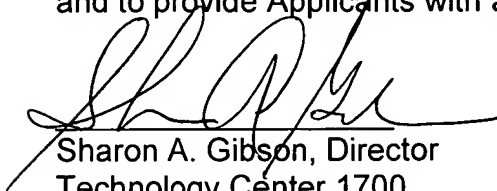
To determine whether both the abstract and the underlying document are prior art, a copy of the underlying document must be obtained and analyzed. If the document is in a language other than English and the Examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the Examiner is relying upon in support of the rejection. The record must also be clear as to whether the Examiner is relying upon the abstract or the full text document to support a rejection. The rationale for this is several-fold. It is not uncommon for a full text document to reveal that the document fully anticipates an invention that the abstract renders obvious at best. The converse may also be true, that the full text document will include teachings away from the invention that will preclude an obviousness rejection under 35 U.S.C. 103, when the abstract alone appears to support the rejection. An abstract can have a different effective publication date

than the full text document. Because all patentability determinations are fact dependent, obtaining and considering full text documents at the earliest practicable time in the examination process will yield the fullest available set of facts upon which to determine patentability, thereby improving quality and reducing pendency. When both the abstract and the underlying document qualify as prior art, the underlying document should normally be used to support a rejection.

DECISION

The petition for withdrawal of finality is **GRANTED**.

The Examiner is directed to issue an office action based on the full Todorova et al. reference and to provide Applicants with a full translation.



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